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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/655,131 | 09/05/2000 | Maurice Clarence Kemp | MORN-0006 (108347.00017) | 7549 |

7590 08/08/2003

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| EXAMINER | |
|---|---|
| PAK, JOHN D | |
| ART UNIT | PAPER NUMBER |
| 1616 | 10 |

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/655,131 | KEMP ET AL. | |
| | Examiner | Art Unit | |
| | JOHN D PAK | 1616 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) *2,4-9 and 12-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,10 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 1-58 are pending. Claims 2, 4-9 and 12-58 stand withdrawn from further consideration as being directed to non-elected subject matter. Claims 1, 3 and 10-11 will presently be examined to the extent that they read on the elected subject matter of record, Mg, lactic acid, and sulfuric acid anion.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 10-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4, 7, 9, 10, 12, 16, 17, 19-22, 24, 27, 29, 31-32 of U.S. Patent No. 6,572,908. Although the conflicting claims are not identical, they are not patentably distinct from each other because a prepared nutriment is an obvious variation of the acidic composition that is claimed in the instant application – the nutriment is merely the treated substrate that results from using said acidic composition as intended.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3 and 10-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/48469 for the reasons of record.

WO 00/48469 explicitly discloses an acidic composition containing Group IIA metal, organic acid such as lactic acid, and sulfuric acid anion. See page 10, lines 24-32, page 13, lines 4-9, page 21, line 17, and claims 1-2, 4-6. Low pH and acid normality are disclosed (p. 18, lines 12-27). The prepared solution is disclosed to be less corrosive than sulfuric acid of comparable pH and normality (see p. 20, first full paragraph). The organic acid is disclosed to provide synergistic effectiveness (paragraph bridging pages 20-21).

While the cited reference does not explicitly show a single example of Mg, lactic acid and sulfuric acid anion, the same is fairly suggested, as evidenced above. There are only 6 Group IIA metals, so Mg is immediately envisaged when Group IIA is taught. Applicant's amendatory language, "organic acid generated from a salt of the organic acid" is not clearly distinctive enough to distinguish the organic acid and lactic acid in particular that are disclosed by the cited reference. The amendatory language appears more relevant to a process of making step. Here, the mere fact that the organic acid is generated from a salt of the organic acid does not serve to distinguish anything, because the claims still require the acid, and no more. The fact that the acid was

generated from the salt is immaterial to the examination of the final product, which is only required to contain the acid. Applicant does not require a significant portion of the salt to be actually present in the composition, and given that acids gain or lose protons under equilibrium, it is expected that the composition of the cited reference would contain some lactate species, and similarly, it is expected that applicant's acidic pH composition would have mostly protonated lactic acid.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been fairly suggested, as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN D PAK whose telephone number is (703)308-4538. The examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

JOHN PAK
PRIMARY EXAMINER
GROUP 1600